

081982,965



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NUMBER 081982,965	FILING DATE 12/02/97	FIRST NAMED APPLICANT LOWELL	ATTY. DOCKET NO. G 359292000110
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EXAMINER

JOHN F MORAN  
OFFICE OF COMMAND JUDGE ADVOCATE  
HQ USAMRDC DEPT OF THE ARMY  
FORT DETRICK  
FREDERICK MD 21702-5012

HM22/0622

BLUDENS, R

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 06/22/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 3/2/99
- ☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
- ☐ Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

BEST AVAILABLE COPY

Serial No. 08/982,965  
Art Unit 1648

5 The status of the related application(s) cited at the first  
page of the specification should be updated, if necessary, to  
ensure a properly completed file record. It is noted that the  
filing papers of the instant application indicated that this  
application is a divisional of application Serial No. 08/143,365,  
now U.S. Patent No. 5,726,292. However, Applicant's amendment to  
the first line of the specification indicates that the application  
is a "continuation of application U.S. Serial No. 143,365".  
Applicant should correct the inconsistency and add the correct  
10 series number, i.e., 08/143,365, at the first line of the  
specification. Further, Applicant is again reminded that Applicant  
is **required** to file a request for correction of the filing receipt  
since the file wrapper does not properly refer to the parent  
applications.

15 The text of those sections of Title 35, U.S. Code not included  
in this action can be found in a prior Office action.

The Examiner acknowledges Applicant's Amendment, Paper No. 6,  
filed March 2, 1999. In view of Applicant's Amendment, the status  
of the claims is as follows: Claims 1-4 and newly added claims 5-9  
20 are currently pending before the Examiner.

Applicant should note that the Amendment, Paper No. 6, filed  
March 2, 1999, has only been entered in part. At the top of page  
3. after "Kindly add the following claims:" the language "gp160 and  
[a] proteosome" has not been entered in the specification since the  
25 amendment is unclear and does not correspond with the  
specification. As this amendment bears on the claims, correction  
by Applicant is **required**.

The oath or declaration remains defective. A new oath or  
declaration in compliance with 37 C.F.R. 1.67(a) identifying this  
30 application by its Serial Number and filing date is required. See

M.P.E.P. 602.1 and 602.02. The oath or declaration is defective because:

(1). It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose material information as defined in 37 C.F.R. 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

(2). Applicant has not given a post office address anywhere in the application papers as required by 37 C.F.R. 1.33(a). A statement over Applicant's signature providing a complete post office address is required. Further, Applicant's residence address is illegible.

The rejection of claims 1-4 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention with respect to vaccines is withdrawn in view of Applicant's amendment deleting the terminology "vaccine."

Claims 1-4 and newly added claims 5-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is vague and indefinite in the recitation "comprising gp160 and proteosome" since it is unclear whether there is more than one proteosome

constructed with the gp160. In other words, it is unclear whether the "a" deleted by the amendment, Paper No. 6, is properly deleted. Amendment of claim 1 to more clearly set forth what precisely constitutes the construct of claim 1 would obviate this rejection.

5           Claims 1-4 and newly added claims 5-9 are rejected under 35  
U.S.C. § 103 as being unpatentable over Lowell et al. (U) or Lowell  
et al. (V) or Smith et al. (W) or Avraham et al. (X) in view of  
Ratner et al. (Y) for the reasons of record set forth in the last  
Office Action. Applicant's arguments have been fully considered  
10 but are not deemed persuasive to overcome the rejection. Applicant  
argues that the rejection constitutes an "obvious to try" argument  
and that the references are not prior art to the instant  
application (see Paper No. 6, page 5). This is not persuasive.

15           With respect to the references not being prior art, the parent  
application, Serial No. 07/065,440, is not available to the  
Examiner at this time. Applicant should consider submitting a copy  
of the original specification of the parent application as a means  
to overcoming the art.

20           With respect to the "obvious to try" argument, Applicant's  
claims are only directed to compositions and methods for inducing  
antibodies. As gp160 is a large protein and since proteosomes were  
known in the art to enhance immunogenicity, one of ordinary skill  
in the art would have reasonably concluded that a composition of  
gp160 and proteosomes would reasonably give rise to antibodies  
25 specific for gp160. Thus, the prior art provides a reasonable  
expectation of success and does not constitute an "obvious to try"  
argument. The rejection is deemed proper and is maintained.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the

Serial No. 08/982,965  
Art Unit 1648

extension of time policy as set forth in 37 C.F.R. 1.136(a).

5 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION  
IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE  
EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING  
DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED  
UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD,  
THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE  
ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37  
10 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE  
ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR  
RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL  
ACTION.

15 Any inquiry concerning this communication or earlier  
communications from the Examiner should be directed to Robert D.  
Budens at (703) 308-2960. The Examiner can normally be reached  
Monday-Thursday from 6:30 AM-4:00 PM, (EST). The Examiner can also  
be reached on alternate Fridays. If attempts to reach the Examiner  
by telephone are unsuccessful, the Examiner's supervisor, Chris  
Eisenschenk, can be reached at (703) 308-0452.

20 Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist at  
(703) 308-0196.



Robert D. Budens  
Primary Examiner  
Art Unit 1648

25 rdb  
June 20, 1999